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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/562,150

12/23/2005

Yoshihiro Kobayashi

2005-2039A

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09/04/2009

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EXAMINER

VARNUM, RYAN A

ART UNIT

PAPER NUMBER

3751

MAIL DATE

DELIVERY MODE

09/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/562,150 | Applicant(s) KOBAYASHI ET AL. | |
| | Examiner RYAN VARNUM | Art Unit 3751 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/21/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is responsive to the amendment filed on 6/3/2009. As directed by the amendment: claims 1 and 9 have been amended, claim 3 has been cancelled and claim 21 has been added. Thus, claims 1, 2 and 4-21 are presently pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

3. Claims 12, 14 and 17 are rejected under 35 U.S.C. 112, fourth paragraph, as being dependent claims which fail to further limit a previously set forth claim. The above cited claims make reference to currently cancelled claim 3, and therefore are not written in proper dependent format. The Examiner has taken the position that these claims are intended to depend from the currently amended Claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

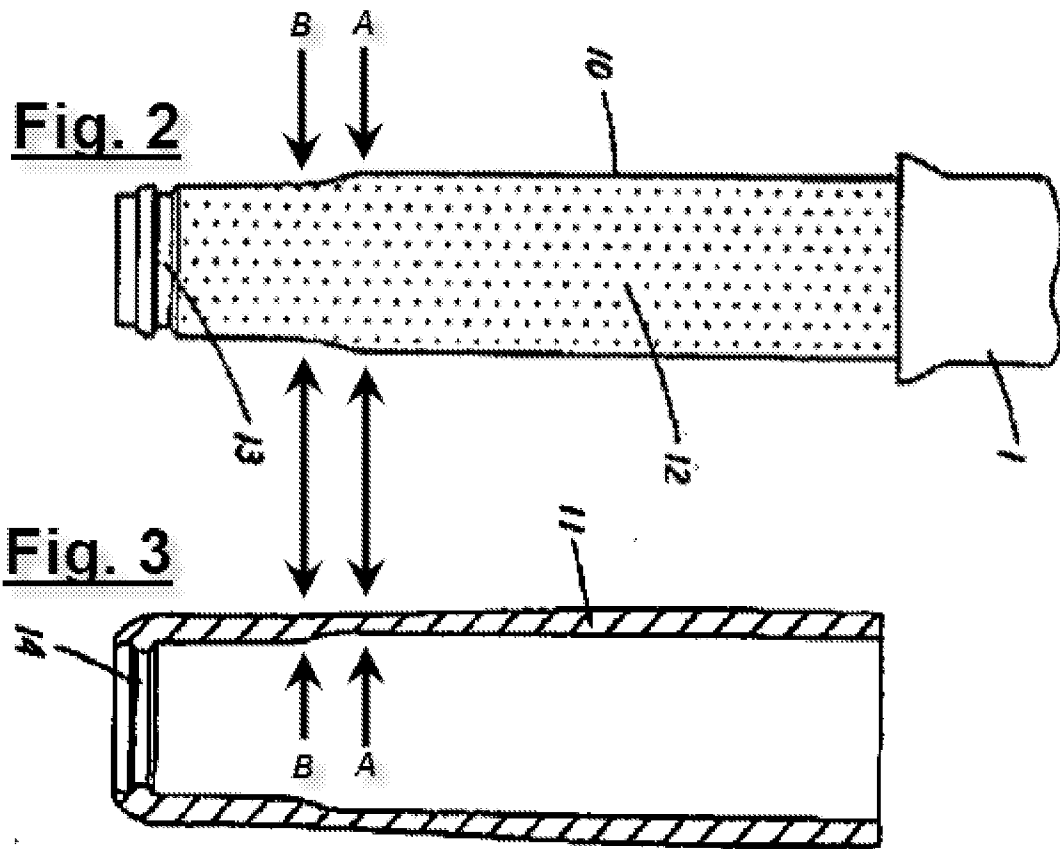
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 5, 8, 9, 13, 14 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kazunori (JP Publication 11-216985). Applicant is advised that all citations to the Kazunori reference hereafter are made with respect to the machine translation, a copy of which has been provided with this action.

6. In re Claim 1, Kazunori discloses a barrel for a writing implement, comprising: a barrel body 1 (“shaft tube”; Fig. 1) having a gripping part 10/11 (Fig. 1); and a grip member 10/11 (Fig. 1) of layered structure formed by assembling an inner member 10 (“diameter reduction part”; Fig.’s 1 and 2) of a soft material (“blow molding”; Para [0007]; it being understood that blow molding is a process used for forming soft materials such as thermoplastics) and an outer member 11 (“grip member”; Fig.’s 1 and 3), the grip member being disposed on the gripping part of the barrel body (Fig. 1), wherein the inner member is covered with the outer member (Fig. 1), and the grip member is formed in an assembly facilitating shape for facilitating putting the outer member on the inner member (Fig.’s 1-3; Para [0011]), wherein each of the inner member and the outer member is formed prior to putting the outer member on the inner member such that each of the inner member and the outer member constitutes a preformed member (Para [0011]), and wherein the assembly facilitating shape is a tapered configuration (Fig.’s 1-

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3), the inner member being tapered from a back part thereof to a front part thereof and the outer member being tapered from a front part thereof to a back part thereof (See Annotated Fig.'s 2 and 3 below; it being understood that inner member 10 tapers from back part A to front part B, while outer member 11 tapers, in cross-section, from front part B to back part A).



Annotated Fig.'s 2 and 3

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7. In re Claim 2, Kazunori further discloses the assembly facilitating shape is a protruding and depressed shape (See Annotated Fig.'s 2 and 3 above; the inner member 10 being in a protruding shape along its back portion behind location A, and depressed along its forward portion ahead of location B; the outer member 11 likewise being in a protruding shape along its front portion ahead of location B and depressed along its back portion behind location A).

8. In re Claims 5, 13 and 14, Kazunori further discloses the outer member 11 (Fig.'s 1 and 3) is transparent (Para [0010]) and the inner member 10 (Fig.'s 1-2) is colored in a color different from that of the outer member ("grip member is not visible to the same color [as the] shaft tube [and] is transparent"; Para [0011]).

9. In re Claims 8, 9 and 21, Kazunori further discloses the inside diameter of the outer member 11 (Fig.'s 1 and 3) is greater than the outside diameter of the inner member (Fig.'s 1-2), and the outer member is axially compressed when put on the grip part of the barrel body ("pressed fit"; Para [0006]); the outer member is provided with a radially inwardly extending protrusion 14 ("projection"; Para [0006]) at the front part thereof (See Fig. 3), and wherein a back end surface of the protrusion is in contact with the front end surface of the inner member 10 (Para [0006]; it being understood that when the "projection 14" engages "slot 13" that a back end of said projection will contact a front surface of slot 13, which is itself located at the front end surface of inner member 10); and the front part '**B**' of the outer member 11 (Fig. 3) circumscribes the front part '**B**' of the inner member 10 (See Annotated Fig.'s 2 and 3 above) and the back part '**A**' of the outer member circumscribes the back part '**A**' of the inner member (See Annotated

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Fig.'s 2 and 3 above) such that the inner member and the outer member are tapered in opposite directions (Annotated Fig.'s 2 and 3 above have been annotated in a side-by-side view to show how locations '**A**' and '**B**' of the two members will align when assembled).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kazunori. Although Kazunori does not disclose the outer member having a mean wall thickness between 1 and 5 mm, it is the Examiner's opinion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the outer member with recited range, for the purpose of optimizing the wall thickness to provide a specifically desired translucency quality of the outer member, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

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12. Claims 4, 6, 7, 11, 12, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kazunori in view of Siegel (US Patent 3,250,033).

13. In re Claims 4, 11 and 12, although Kazunori does not disclose the outer member being separable from the inner member, attention is directed to Siegel which teaches a writing implement having a barrel body 11 (Fig. 2) including a gripping portion comprising an outer member 23 (Fig. 1) and inner member 20 (Fig. 1) wherein the outer member is put on the inner member so as to be separable from the inner member and the barrel body (Column 2, Lines 27- 29), for the purpose of facilitating removal and replacement of the separate members (Column 2, Line 29).

14. Accordingly, it would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to modify the device of Kazunori, such that the outer member is put on the inner member so as to be separable from the inner member and the barrel body, as taught by Siegel, for the purpose of facilitating removal and replacement of the separate members.

15. In re Claim 15, as applied to Claim 4 above, Kazunori further discloses the outer member 11 (Fig.'s 1 and 3) is transparent (Para [0010]) and the inner member 10 (Fig.'s 1-2) is colored in a color different from that of the outer member ("grip member is not visible to the same color [as the] shaft tube [and] is transparent"; Para [0011]).

16. In re Claims 6, 7 and 16-20, although Kazunori does not expressly disclose the outer and inner members having different hardnesses, attention is directed to Siegel which teaches a writing implement having a barrel body 11 (Fig. 2) including a gripping portion comprising an outer member 23 (Fig. 1) and inner member 20 (Fig. 1) wherein

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the inner member and the outer member may be made of materials of different hardnesses, respectively ("plastic" and "glass" respectively; Column 2, Lines 27-34), the inner member being made of a soft material having a low hardness ("plastic"), and the outer member being made of a soft material having a high hardness ("glass"); wherein the inside surface of the outer member is glossy (it being understood that the surface of glass is glossy), for the purpose of constructing the gripping member of materials which will provide the desired visual characteristics and gripping surface (Column 1, Lines 9-18).

17. Accordingly, it would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to modify the device of Kazunori, such that the outer member had a higher hardness than the inner member, as taught by Siegel, for the purpose of constructing the gripping member of materials which will provide the desired visual characteristics and gripping surface.

Response to Arguments

18. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN VARNUM whose telephone number is (571) 270-7853. The examiner can normally be reached on Monday - Friday, 9:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. V./

Examiner, Art Unit 3751

/David J. Walczak/

Primary Examiner, Art Unit 3751